

Application No. 09/940,519

Reply dated March 22, 2005

Response to Office Action dated November 22, 2004

REMARKS/ARGUMENTS

Description of amendments

Claims 6 and 13-18 are now pending and under examination. Applicant has amended claim 6; rewritten claims 4 and 5 in independent form and renumbered them claims 13 and 14, respectively; added claims 15-18; and cancelled claims 3-5 and 7. No new matter has been added.

The new claims are supported by the application as originally filed. Specifically, claim 15 is supported by the specification at page 7, lines 17-20; claim 16 is directed to the subject matter of original claim 6; and the support for claim 16 can be found on page 7, lines 21 and 22.

Rejections under 35 U.S.C. §§102 and 103(a)

The rejection of claims 3 and 7 under 35 U.S.C. §102 is rendered moot by the cancellation of claims 3 and 7. The rejection of claim 6 under 35 U.S.C. §103(a) is rendered moot by the amendment to claim 6.

Claim 4 (now claim 13) was rejected under 35 U.S.C. §103(a) as being unpatentable over Becker (U.S. Patent 2,738,864), Dover (U.S. Patent 5,678,675), or Savoyard (U.S. Patent 6,585,095), in view of Yesnik (U.S. Patent 5,048,654). Claim 5 (now claim 14) was rejected under 35 U.S.C. §103(a) as being unpatentable over Becker, Dover, or Savoyard, in view of JP 405231443. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 4 and 5.

Applicant disagrees with the Examiner's contention that Yesnik teaches the subject matter of claim 4, and JP 405231443 teaches the subject matter of claim 5. Claim 4 is directed to coated separator plates. Yesnik teaches also coated separator plates. However, coating in Yesnik is applied to enhance the frictional characteristics of a clutch (see, for example, column 1, lines 10-11).

This means that Yesnik is concerned with the friction characteristics between each friction plate and its associated separator plates. In the presently claimed invention, on the other hand, coating is applied to the opposing surfaces of two adjacent groove-free separator plates, which are placed between two adjacent friction plates. Since Yesnik teaches enhancing the frictional characteristics of a clutch, it would not have motivated a person skilled in the art to apply coating to the opposing surfaces of two adjacent separator plates, because the opposing surfaces of two adjacent separator plates are irrelevant to the frictional characteristics of a clutch.

Claim 5 is directed to machined separator plates. JP 405231443A teaches also machined separator plates. However, in JP 405231443A, the separator plates are machined to adjust their surface roughness such that the coefficient of friction can be stabilized in a new clutch. This means that JP 405231443A is concerned with the friction characteristics between each friction plate and its associated separator plates. Like Yesnik, JP 405231443A cannot motivate a person skilled in the art to machine the opposing surfaces of two adjacent separator plates, because the opposing surfaces of two adjacent separator plates are irrelevant to the frictional characteristics of a clutch.

Different from Yesnik and JP 405231443A, the presently claimed invention is concerned with the prevention or reduction of heat spots on separator plates (see page 2, lines 23-25). Coating allows even contact between two separator plates, thereby preventing or reducing heat spots on the separator plates (see, page 7, lines 13-14, and page 6, lines 24-25). Machining makes it possible to maintain a very small clearance between two separator plates and to facilitate the holding of lubricating oil between two separate plates (see page 7, lines 21-25). The lubricating oil is effective in the prevention or reduction of heat spots on the separator plates.

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To summarize, in claims 4 and 5 it is the non-friction surfaces of the separator plates that are coated and machined, while in Yesnik and JP 405231443A it is the friction surfaces of the separator plates that are coated and machined.

Additionally, Applicant respectfully submits that the *Savoyard* patent is not prior art to the present application under 35 U.S.C. §102(e). As indicated in the attached Declaration, the inventor of the present application conceived the claimed invention and reduced it to practice before August 7, 2000, which was the filing date of the Savoyard application. In fact, the claimed invention had been tested before August 7, 2000, as discussed in the attachment to the Declaration. Additionally, Savoyard and the present application claim different inventions. The present invention claims a wet multi-plate clutch, while Savoyard claims an oil cooling system. Therefore, Savoyard is not prior art to the claimed invention under 35 USC §102(e).

Amended claim 6 is also patentable, because it depends from patentable claims 13 and 14.

Patentability of new claims 15-18

New claims 15-18 are patentable, because they depend from patentable claims 13 and 14.

In light of the foregoing remarks, this application is considered to be in condition for allowance, and early passage of this case to issue is respectfully requested. If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and

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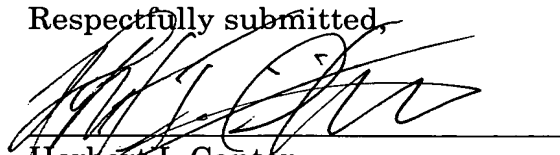
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please charge any deficiency in fees or credit any overpayments to Deposit
Account No. 05-1323 (Docket #038769.50357US).

March 22, 2005

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'H. I. Cantor', written over a horizontal line.

Herbert I. Cantor

Registration No. 24,392

CROWELL & MORING LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844
HIC:SZ:tlm (038769.50357US; 366974)